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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,838	04/04/2001	Romano Mark	8932-392	2746

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EXAMINER

DANGANAN, JONI BALDOS

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 12/11/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/824,838

Applicant(s)
Mark et al.

Examiner
Joni Danganan

Art Unit
3723



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other: _____

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

page 2, line 7, recites a "borehole flush with the groove concentric to the central axis" -- this appears to be inaccurate/misdescriptive since the axis of the borehole is actually parallel to the central axis and not concentric with it.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 6-7 recite a "borehole flush with the groove concentric to the central axis." As discussed above this appears to be inaccurate/misdescriptive since the axis of the borehole is actually parallel to the central axis and not concentric with it.

Claim 8 recites the elastic component "can bend" perpendicular to the central axis. The scope of the claim is not clear. Is applicant claiming that the elastic component is bent perpendicular to the

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central axis or merely that the elastic component is capable of being bent perpendicular to the central axis?

It is not clear how Claims 14-20, which are directed to the screw and the device, further limit the "method" of securing a screw.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryder et al. 5,237,893.

Fig. 4 of Ryder et al. discloses a device for securing a screw comprising a longitudinal shank having a central axis; a spindle having a substantially polygonal-shaped cross-section with a plurality of rounded edges and a plurality of concave side surfaces, a groove (outer end of 42) substantially parallel to the central axis and a borehole (circular portion of 42) flush with the groove; and an elastic component (44) inserted into the borehole and groove. Regarding Claim 10, the method of forming the device is not germane to the issue of patentability on the device itself; therefore, this limitation has not been given any substantial patentable weight.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryder et al. 5,237,893.

Ryder et al. shows all the elements of this claim, as set forth in the rejection of Claim 1, except for the groove being flush with one of the rounded edges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ryder et al. by forming the groove flush with one of the rounded edges since it has been held that rearranging parts of an invention involves only routine skill in the art. Ryder et al. also discloses the claimed method of securing a screw except for the specific utilization of the tool within a body. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ryder et al. for use in implanting a screw into a body or any other environment depending on the desired application or environment.

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryder et al. 5,237,893 in view of Fedotoff 1,951,652.

Ryder et al. shows all the elements of these claims except for the elastic component being a spring wire. Fedotoff teaches that it is known in the art to form the elastic retaining component of

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a driving device as a spring wire (7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ryder et al. by utilizing a spring wire elastic component in order to simplify manufacture of the device. Regarding the specific size of the wire, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Figs. 8-11 of Totsu 3,687,179 disclose a driving device similar to the disclosed invention.

Jacobson 2,013,826 discloses a driving device similar to the disclosed invention.

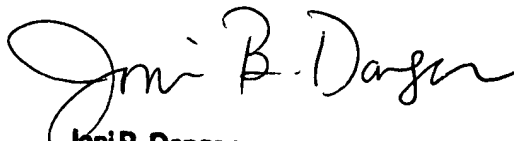
Learned 3,286,749 discloses a driving device in the related art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joni Danganan whose telephone number is (703) 305-5930.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

jbd

December 5, 2001


Joni B. Danganan
Patent Examiner

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.